



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,959	02/26/2002	Seah H. Lim	010.00131	5006

7590 05/26/2006

Kathy Smith Dias Esq
Heslin Rothenberg Farley & Mesiti P C
5 Columbia Circle
Albany, NY 12203-5160

EXAMINER

UNGAR, SUSAN NMN

ART UNIT	PAPER NUMBER
----------	--------------

1642

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/082,959	LIM ET AL.	
	Examiner	Art Unit	
	Susan Ungar	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on March 20, 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The Amendment filed March 20, 2006 in response to the Office Action of September 22, 2005 is acknowledged and has been entered. Previously pending claim 6 has been amended. Claim 6 is currently being examined.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The following rejections are being maintained:

Claim Rejections - 35 USC 112

4. Claim 6 remains rejected under 35 USC 103 for the reasons previously set forth in the paper mailed September 22, 2005, Section 4, page 4.

Applicant argues that, contrary to Examiner's statement, the disclosures of each of the publications cited in the application are incorporated by reference in the application and points to page 1, lines 21-27. The argument has been considered and upon review of page 1, lines 21-27, Examiner has indeed found the statement drawn to incorporation by reference. Examiner apologizes for any inconvenience. It is noted however that mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. In re de Seversky , 474 F.2d 671, 177 USPQ 144, (CCPA 1973). In addition to other requirements for an application, the referencing application should include an identification of the referenced patent, application, or publication. Particular attention should be directed to specific portions of the referenced document where the subject matter being incorporated may be found. Further, Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner

representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. In re Hawkins , 486 F. 2d 569, 179 USPQ 157 (CCPA 1973); In re Hawkins , 486 F. 2d 579, 179 USPQ 163 (CCPA 1973); In re Hawkins , 486 F. 2d 577, 179 USPQ 167 (CCPA 1973). Further, if Applicant were to amend the specification and provide the required declaration, In order to avoid a new matter rejection when amending the claim to uniquely identify the SP17 with a sequence identifier, Applicant would also be required to provide a nexus between the teachings in the specification and the sequence information in the Lea et al reference, that is, to unambiguously demonstrate that the claim as originally filed was specifically drawn to a cytotoxic T cell that recognizes human SP17 and not for example a cytotoxic T cell that recognizes mouse, rabbit or baboon SP17, especially since the Lea et al reference discloses not only sequences associated with human SP17 but also sequences of rabbit and mouse SP17.

Applicant states that for clarification purposes, the abbreviation Sp17 is replaced with the full protein name “sperm protein 17”. The clarification has been considered but has not been found persuasive for the reasons previously set forth, that is, that the claimed SP17 is not limited to the SP17 of Lea et al.

Applicant requests, in view of the amendment of the claim, that the rejection be withdrawn. The request has been considered but the rejection is not withdrawn because the amendment to disclose the full name of the protein does not remedy the deficiencies of the claim wherein the SP17 claimed is not unambiguously claimed.

The arguments, clarifications, requests have been considered but have not been found persuasive and the rejection is maintained.

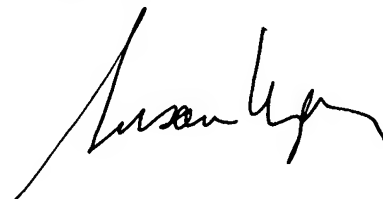
5. All other objections and rejections set forth in the previous office action are hereby withdrawn.
6. No claims allowed.
7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Ungar, PhD whose telephone number is (571) 272-0837. The examiner can normally be reached on Monday through Friday from 7:30am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew, can be reached at 571-272-0787. The fax phone number for this Art Unit is (571) 273-8300.

Effective, February 7, 1998, the Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1642.



SUSAN UNGAR, PH.D.
PRIMARY EXAMINER
5/18/06

Application/Control Number: 10/082,959
Art Unit: 1642

Page 5

Susan Ungar
Primary Patent Examiner
May 18, 2006

Signature
on Previous Page